

an integral construction is formed by blanking and bending a single copper alloy sheet. (See Togashi, col. 5, lines 6 to 13). The reference also indicates that the central terminal portion includes two downwardly-projecting terminal piece portions and that it has an inverted U-shaped vertical section. (See Togashi, col. 5, lines 14 to 17; see also Togashi, Figs. 1 to 5).

It is therefore respectfully submitted that any review of the Togashi reference makes plain that it simply does not in any describe or even suggest a device for contacting an *electrically operated apparatus*, in which "at least one sleeve contact and . . . at least one terminal contact [are] *adapted to be assembled together parallel to the installation direction*" of the electrically operated apparatus, and in which the "at least one sleeve contact includes two concentric sleeve contacts" and the "at least one terminal contact includes two concentric terminal contacts" so that the "two sleeve contacts connect to the two terminal contacts", as in claim 1 as presented. Accordingly, the Togashi reference simply does not describe (or even suggest) these features of claim 1.

In particular, as previously discussed, the reference concerns a coaxial connector and not an electrically operated apparatus, as that phrase is understood in the context of the present application. In this regard, the present application provides the following as regards the problems addressed and the solution and benefits provided by the subject matter of claim 1:

Electrically operated apparatuses, e.g., hydraulic actuators such as solenoid valves and pressure regulators, must frequently be installed with a directional orientation in further processing, so that the electric contacts are located in a defined position. This is necessary, for example, when an arrangement of actuators is to be contacted jointly and electrically in one operation. For example, if the terminal contacts of the actuator are arranged laterally to its longitudinal axis, the position of the actuator must usually be changed, so that the terminal contacts can be connected to a suitable plug. The respective precise orientation of the actuators is an additional operation that is to be avoided. In addition, lateral contacting of the actuator leads to the result that tolerances in its longitudinal direction can hardly be compensated because, with radial contacting, displacement in the direction of the longitudinal axis is possible only to a limited extent because the contact area of the internal contact is usually limited. In radial contacting, the direction of joining of the actuator and of the plug contact are not identical, so two assembly directions are necessary when assembling the actuator on a carrier and when assembling the plug on the apparatus, so the assembly operation must necessarily be sequential.

[An object of an exemplary embodiment] is to provide a device for contacting an electrically operated apparatus, so that the contacting can be accomplished with less orientation complexity, and tolerances in the

longitudinal direction of the apparatus can be compensated easily. [Another object] is to permit simultaneous assembly of the apparatus and the plug.

According to the [exemplary embodiment], *the terminal contact is oriented parallel to an installation direction of the apparatus, and the sleeve contact can be connected to the terminal contact parallel to the installation direction.*

It has been found . . . that assembly of one or more apparatuses on a carrier and connecting the respective plugs to the apparatuses can be accomplished simultaneously by axial contacting. If the plugging direction of the plugs corresponds to the installation direction of the apparatuses, only a precise radial orientation of the plugs is necessary, and thus axial compensation of tolerance is possible in the installation direction of the apparatuses due to the fact that the plugs need not be pushed onto the terminal contacts as far as the stop. Then contacting with a punched grid, for example, can take place simultaneously with assembly of an actuator. At the manufacturing plant, one direction of assembly may be eliminated through the axial assembly of the plugs, thereby reducing the expense in terms of workpiece carriers and devices.

....

[When] the sleeve contacts are . . . each in contact with the concentric terminal contacts on the outside circumference when joined together. This results in an especially large contact area between the terminal contacts of the apparatus and the sleeve contacts.

In [another embodiment], the terminal contacts are two contact faces bent into a cylindrical shape in particular and provided on the end of an apparatus casing. These contact faces have different diameters and are arranged accordingly, so that an insulation bushing can optionally be inserted between the coaxial terminal contacts, and the two sleeve contacts of the plug can be inserted without causing a short circuit between the sleeve contacts and the terminal contacts.

(Specification, page 1, line 7 to page 3, line 11) (emphasis added). Accordingly, a coaxial connector is not an “electrically operated apparatus” as defined by the specification.

The law plainly supports the foregoing eminently reasonable interpretation of “electrically operated apparatus” based on the specification. (See *In re Weiss*, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must “look to the specification for the meaning ascribed to that term”; Board reversed) (unpublished decision); *In re Okuzawa*, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) (“claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest *reasonable* interpretation”; Board reversed; emphasis in original) (citing

In re Royka, 180 U.S.P.Q. 580, 582-83 (C.C.P.A. 1974) (claims are “not to be read in a vacuum and while it is true that they are to be given the broadest reasonable interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a part”; Board reversed; emphasis in original); and *In re Rohrbacher*, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an “applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification”; Board reversed)). It is respectfully submitted that this is exactly the case here since contrary to the foregoing law, the Office Action simply reflects its own unreasonable reading of “electrically operated apparatus” without regard to the sense in which those terms are used in the specification.

It is therefore respectfully submitted that claim 1 is allowable.

Since claims 3 to 19 depend from claim 1, these claims are allowable for the same reasons as claim 1.

With respect to paragraph four (4) of the Office Action, claim 16 was rejected under 35 U.S.C. § 103(a) as obvious over the Togashi reference in view of Beloritsky, U.S. Patent No. 6,036,540 (“the Beloritsky reference”).

As discussed above, the primary Togashi reference does not in any way disclose or suggest the features of claim 1. Since claim 16 depends from claim 1, the Togashi reference does not in any way disclose or suggest the features of claim 16 for essentially the same reasons as claim 1. The secondary Beloritsky reference purportedly concerns a coaxial connector including a substantially cylindrical ring contact and a receptacle shell. (See Beloritsky, Abstract). Any review of the Beloritsky reference makes plain that it simply does not cure the critical deficiencies of the Togashi reference with respect to the features of claim 1 discussed above, especially since it also concerns a coaxial connector. It is therefore respectfully submitted that claim 16 is allowable over the references as applied.

As further regard the obviousness rejections, in the Response to Arguments, the Office Action effectively admits that the Togashi reference does not describe or even suggest that at least one terminal including two concentric terminal contacts, the two sleeves contacts connecting the two terminal contacts; but, asserts that because an “explanation of why this feature is critical to the invention” was not given then it is the “Examiner’s opinion that this feature is an obvious matter of design choice.” Applicants respectfully suggests that the specification describes the usefulness of the claimed features in the subject application. In particular, at page 1, line 25 to page 2, line 2, the specification makes plain that the contacting is accomplished with less orientation complexity and better compensation of tolerances in the

longitudinal direction of the apparatus. Further, at page 3, line 1 to 3, the specification provides that, in at least one exemplary embodiment, the sleeve contacts are each in contact with the concentric terminal contacts on the outside circumference with joined together resulting in an especially large contact area between the terminal contacts of the apparatus and the sleeve contacts. The specification at page 3, line 5 et seq. describes further advantages to having the arrangement as claimed in claim 1.

Indeed, in view of the foregoing, the subject application provides *additional and different* features that are not described in the Togashi reference, unlike situations where it is merely a difference in dimensions, or the like (to which is what it appears the Office Action is alluding). Further, in view of the foregoing, there are advantages to the arrangement as claimed in at least claim 1 and as described throughout the specification of the subject application.

As further regard the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied*, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998), which as referred to above simply do not address the problems met by the subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action’s assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not even the case here, there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed", stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe

the features discussed above of the rejected claims.

It is therefore respectfully submitted that claims 1 and 3 to 19 are allowable.

CONCLUSION

In view of all the above, it is believed that rejections of claims 1 and 3 to 19 have been obviated, and that currently pending claims 1 and 3 to 19 are allowable. It is therefore respectfully requested that the rejections be reconsidered and withdrawn, and that the present application issue as early as possible.

Respectfully Submitted,
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